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JUN -1 2006

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In re Application of: Cremers, et al.  
Appl. No.: 10/657,583  
Filed: September 8, 2003  
For: Taco Shell Nesting Apparatus and Method

DECISION ON PETITION

This is a decision on the petition filed on August 5, 2005 by which petitioners request withdrawal of the restriction requirement made FINAL in paper No. 05312005 dated June 6, 2006 and that claims 1-17 and 32 be examined in this application. The petition is considered pursuant to 37 CFR 1.181 and 37 CFR 1.144, and no fee is required.

The petition is GRANTED

Review of the application and of the claims shows that the Examiner initially required restriction in paper No. 01062005 dated January 7, 2005 between seven groupings among claims 1-31 directed to various disclosed subcombinations and methods. In response to the initial requirement, Applicant elected, with traverse, the subcombination of Group I, claims 1-4, and cancelled method claims 18-31 apparently agreeing with the restriction between the claimed methods and apparatus as per pages 4 and 5, the bridging paragraph, of this petition. New claim 32 was added as a combination claim and included all the particulars of each claimed subcombination.

In paper No. 05312005 dated June 6, 2006, the Examiner redrafted the restriction requirement by grouping the claims into five groups; Groups I-IV for the various subcombinations and Group V for the combination. The Examiner justified the restriction based on the MPEP section 806.05 (d) for requiring restriction between subcombinations usable together. The Examiner has shown that each subcombination, as claimed, has utility other than in the disclosed combination. Furthermore, since each subcombination as claimed do not overlap in scope, i.e., each subcombination claim sets forth limitations only for that subcombination and not any of the others, and since each subcombination as claimed are not obvious variants, distinctness between the four subcombinations exists. Also, in satisfying whether a burden exists to examine all the claimed inventions, the Examiner's reasoning that each subcombination as claimed would involve separate fields of search has not been contested by Applicant. Moreover, it is most apparent that the subcombinations, as claimed, do in fact involve such divergent subject matter that would lead to diverging fields of search and impose a serious burden on the Examiner.

However, the Examiner's justification in restricting between the invention of Group V (claim 32) and the inventions of Groups I-IV (claims 1-17) is not in accordance with the guidelines defined in the MPEP 806.05(c). In order to show distinctness here, the Examiner must demonstrate two things: 1) that the "combination as claimed does not require the particulars of the subcombination as claimed for patentability" and 2) that "the subcombination can be shown to have utility either by itself or in another and materially different combination". Clearly every word of independent subcombination claims 1, 5, 11 and 15, verbatim, is included in independent combination claim 32. Since the combination as claimed does require the particulars of each subcombination as claimed, the inventions cannot be considered distinct. The Examiner's reasoning that "the combination as claimed does not require the particulars of the subcombination as claimed for patentability because other [each] subcombination in the combination is also patentable by itself" is not commensurate with the guidelines defined above.

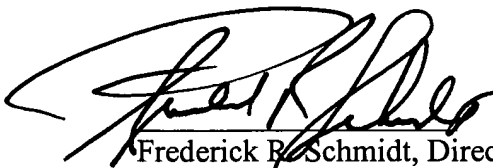
As per guidelines set forth in the MPEP section 806.05, "Where two or more inventions are claimed, the principal question to be determined in connection with a requirement to restrict or a rejection on the ground of double patenting is whether or not the inventions are distinct. If they are distinct, restriction may be proper. If they are not distinct, restriction is never proper. If non-distinct inventions are claimed in separate applications or patents, double patenting must be held, except where the additional applications were filed consonant with a requirement to restrict."

Should Applicant be compelled to file any of the subcombination inventions or the combination invention in divisional applications which complies with the requirements of 35 U.S.C. 120 as a result of the restriction requirement made in this application, a double patenting rejection would be prohibited under 35 U.S.C. 121. Therefore, the restriction between Groups I-V as delineated by the Examiner must be considered improper and claims 1-17 and 32 must be given full consideration on the merits.

For the reasons outlined above, the restriction requirement promulgated and construed as being made final is not in accordance with proper Office procedure. Accordingly, the Office action rendered in paper No. 05312005 is hereby vacated.

As a further procedural note, as this petition grants Petitioner relief from the restriction requirement, the amendment presented August 23, 2005 is deemed responsive to which a new Office action will be rendered. The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3721 who will have the examiner promulgate an action on the merits of the presently pending claims not inconsistent with this Decision.

PETITION GRANTED



Frederick R. Schmidt, Director  
Technology Center 3700